UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,372	09/28/2000	Louis A. Lippincott	042390.P9464	7664

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EXAMINER
BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/672,372	LIPPINCOTT, LOUIS A.
	Examiner	Art Unit	
	KIEU-OANH T. BUI	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 October 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-29, with new claims 25-29 added, have

been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or*
> *described as set forth in section 102 of this title, if the differences between the subject*
> *matter sought to be patented and the prior art are such that the subject matter as a whole*
> *would have been obvious at the time the invention was made to a person having ordinary*
> *skill in the art to which said subject matter pertains. Patentability shall not be negatived*
> *by the manner in which the invention was made.*

3.   Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aras et al.

(U.S. Patent No. 5,872,588) in view of Ellis (US Patent Pub 2002/0059610 A1).

Regarding claim 1, Aras discloses "an apparatus" (Fig. 1A, item 111 & Figs. 15-16 for a

home station) comprising: "a first processor coupled to a communications channel device, the

communications device capable of receiving and transmitting information to a video-on-demand

(VOD) service provider", i.e., the processor of Figure 16 coupled to an upstream or control

channel as a communications channel device for receiving and transmitting to a VOD service

provider –as shown in Fig. 1A for a broadcast server and ITV server (col. 6/line 45 to col. 7/line

29 for VOD service is included); "a VOD content decoder coupled to the first processor" (Fig.

16, an AVI decoder for decoding the audio/visual content, and col. 7/line 5 to col. 8/line 53 for

details on fields and contents of AVI frames, as also illustrated in Fig. 2); "a video and audio

formatting processor coupled to the first processor and the content decoder" (as shown in Figs.

15 & 16, decode module 1561 decode the audio and visual information and presents audio and

video to the display 1563, wherein it is also coupled to the processor as shown in detail in Fig.

16); and "an index memory coupled to the first processor, wherein the index memory stores a

plurality of VOD program segment representations of <u>at least one</u> partial VOD program content"

(Fig. 16 shows a memory wherein the memory stores index of VOD segment programs of either

a whole VOD program content or portions of program content, see more on col. 7/line 58 to col.

9/line 16 for separate sub-portion identifiers and time index for identifying portions of programs

presenting to each viewer, and Figs. 10-12 for time index including start time and end time of

each AVI stream).

Aras does not further show that the start and stop segments are from a recorded show that

has already been viewed after the user selects the start and stop times, i.e., a prerecorded

segment; however, Ellis teaches a same technique since portions or program segments (page 3,

par. 0036 for portions can be implemented on the interactive television for interactive sessions)

can be stored for replays on a prerecorded medium or storage (page 4, par. 0043) with a segment

such as "Mad about you" starting from 8PM and ending 8:30PM can be selected and added to

watch list using button 802 (Fig. 9) and use a VCR or a recordable digital video disc for

recording for viewing at a later time as suggested in par. 0043 of page 4. Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Aras' system with Ellis's teaching technique of including prerecorded segments as taught

by Ellis in order to replay for selected segments at ease.

As for claim 2, in further view of claim 1, Aras discloses "wherein the first processor receives information from a user controller" (Fig. 15 as subscriber 113 uses I/O control 1553 for controlling the processor within the monitor 1555—as the processor later shown in Fig. 16).

As for claim 3, in further view of claim 2, Aras shows "wherein the user controller is one of an infrared remote controller, a keyboard, a computer mouse and a voice activated controller" (col. 5/lines 56-67 for remote controller; and Fig. 15-16, and col. 25/line 36 to col. 26/line 5 for a variety of different user inputs).

As for claim 4, in further view of claim 1, Aras further discloses "wherein the plurality of VOD program segment representations comprises a content identification, a content segment start time, and a content segment stop time" (Fig. 2 shows AVI stream with content fields and ID, and Fig. 12 for start time and stop time of each AVI stream identifying by its own ID).

As for claim 5, in further view of claim 4, Aras shows "wherein the content identification is one of received from a VOD service provider and selected by a user" (as shown in Figs. 12-13, and col. 23/line 40 to col. 24/line 10 as viewers can select the AVI stream portions presented to them for appropriate billing purposes).

As for claim 6, in further view of claim 5, Aras shows "wherein the content segment start time and the content segment stop time are selected by a user" (see claim 4 & 5 as viewer can select the AVI portions by each AVI content start time and end time).

As for claim 7, in view of claim 4, Aras inherently teaches "wherein one of the plurality of program segment representations requires 1 to 10 bytes of memory", i.e., allocation of memory is assigned based on behavior collection data using standard NTSC format for bytes (col. 13/line 34 to col. 14/line 43).

As for claim 8, in further view of claim 1, Aras further discloses "wherein the index memory is a non-volatile read and write memory" (home station includes non-volatile memory, see col. 16/lines 45-51).

Regarding claim 9, Aras discloses "a system comprising: a video-on-demand (VOD) service provider coupled to a plurality of settop-box (STB) units, wherein each of the plurality of STB units comprises a first processor coupled to a communications channel device, the communications device capable of receiving and transmitting information to a VOD service provider; a VOD content decoder coupled to the first processor; a video and audio formatting processor coupled to the first processor and the content decoder; and an index memory coupled to the first processor, wherein the index memory stores a plurality of VOID program segment representations of <u>at least one</u> partial VOD program content and each of the plurality of STB units are capable of communicating with each other" (same as claim 1 above, with set top box or set top terminal at the user location as shown in Figs. 1A & 1B, and col. 4/lines 40-57 & col. 5/lines 39-67).

Aras does not further show that the start and stop segments are from a recorded show that has already been viewed after the user selects the start and stop times, i.e., a prerecorded segment; however, Ellis teaches a same technique since portions or program segments (page 3, par. 0036 for portions can be implemented on the interactive television for interactive sessions) can be stored for replays on a prerecorded medium or storage (page 4, par. 0043) with a segment such as "Mad about you" starting from 8PM and ending 8:30PM can be selected and added to watch list using button 802 (Fig. 9) and use a VCR or a recordable digital video disc for recording for viewing at a later time as suggested in par. 0043 of page 4. In addition, Ellis

teaches that the set top box can communicate with each other by using Email function (Ellis,

Figs. 5 & 6, with a letter icon 608 for e-mail to other users using set top boxes, refer to page 5,

par. 0056). Therefore, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to modify Aras' system with Ellis's teaching technique of including

prerecorded segments and e-mail function using the set top box as taught by Ellis in order to

replay for selected segments at ease and to communicate with each other using e-mails.

As for claims 10-16, these claims with same limitations are rejected for the reasons given

in the scope of claims 2-8 as already disclosed in details above.

As for claim 17, Aras discloses "a method comprising: ordering at least one

video-on-demand (VOD) program from a VOD service provider from a first set-top-box (STB)

unit; playing at least one VOD program; selecting a start and stop time for recording a

representation of a segment of the at least one VOD program, wherein the start and stop time are

user selectable; converting a VOD program identifier of the at least one VOD program to a text

representation; one of converting the text representation of the VOD program identifier of the at

least one VOD program into a unique encoded digital representation and receiving a unique

encoded digital representation from the VOD service provider; converting the start and stop time

for a segment of the at least one VOD program to a digital representation; and storing the VOID

program identifier encoded digital representation and the start and stop digital representation in

an index memory" (same as claim 1 and 9 above, with the step of ordering VOD program from

the viewer/user, see col. 3/lines 7-27 & col. 5/lines 39-67 & col. 7/lines 5-53 and col. 23/line 40-

col. 24/line 26 for related information on how the viewer or subscriber orders and selects the

VOD program including portions or segments of VOD program using AVI stream based on start time and end time of each AVI stream presented to the viewer for selection).

As for claims 18-20, Aras inherently shows further "comprising converting the stored VOD program identifier encoded digital representation and the start and stop digital representation of the segment of the at least one VOD program to a graphics representation, wherein a user can select the graphics representation to order the segment of the at least one VOD program" and "attaching the stored VOD program identifier encoded digital representation and the start and stop digital representation in an electronic mail (email), and sending the email to a user located at a different venue" (col. 24/line 29 to col. 25/line 40 while computer software, computer monitor and PDA are used in receiving electronic messages from the system in either audio form and video form, see further in col. 26/line 44 to col. 27/line 4 for VOD services delivered to the users/viewers at different venue or location).

As for claims 21-24, these claims for "a program storage device readable by a machine comprising instructions that cause the machine to: order at least one video-on-demand (VOD) program from a VOID service provider from a first set-top-box (STB) unit; convert a VOD program identifier of the at least one VOD program to a text representation; one of convert the text representation of the VOD program identifier of the at least one VOD program into a unique encoded digital representation and receive a unique encoded digital representation from the VOD service provider; convert a start and stop time for at least one segment of the at least one VOD program to a digital representation, wherein the start and stop time for the at least one segment of the at least one VOD program are user selectable and are based on a stop and a start time of a recorded representation of the at least one segment of the least one VOD program where the at

elast one segment of the at least one VOD program has already been viewed; and store the VOD

program identifier encoded digital representation and the start and stop digital representation in

an index memory" are rejected for the reasons given in the scope of claims 1-17 as disclosed in

details above.

As for claims 25-29, these claims for an apparatus with same limitations as discslsoed

above are rejected for the reasons given in the scope of claims 1-9 with Ellis' disclosing e-mail

function for communicating to each other using set top boxes as discussed earlier.

Conclusion

4.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

5.   **Any response to this action should be mailed to:**

> Commissioner of Patents and Trademarks
> Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

6.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner

can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays

off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Christopher Grant, can be reached on (571) 272-7294.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

> Krista Bui
> Primary Examiner
> Art Unit 2611

KB
May 5, 2005